

the independent claims in the previous amendment filed July 12, 2006 (Claim 1, ln. 12-13; claim 10, ln 19-21; claim 11, ln. 20-22).

Claims 1-2 and 4-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee et al. (US 6,190,913) in view of Gold et al. (US 3,584,143). This rejection is respectfully traversed. In order to establish a *prima facie* case of obviousness “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” M.P.E.P. §2142. Neither Lee et al. nor Gold et al., even when considered in combination, teaches or suggests all limitations of independent claim 1.

Claim 1 recites an image data correcting device comprising, *inter alia*, “determining means for determining whether the first image data corresponds to a halftone image; and intensity changing means for changing an intensity of the first image data to a predetermined low intensity. Claim 1 further recites that “the determining means retains the first image data without change when the first image data corresponds to the halftone image, and wherein said predetermined low intensity corresponds to a background level” (emphasis added). Applicants respectfully submit that Lee et al. does not teach these limitations.

Lee et al. teaches that “[o]nce the halftone pixels in a document image are labeled as represented in the halftone line map on output 18 of FIG. 1, halftone pixel removal process 20 of FIG. 1 is started and strictly applied to the halftone pixels only.” Col. 8, ln. 36-41 (emphasis added). In addition, in FIG. 2A of Lee, if a gray-scale pixel triggers the “NO” path 211, there will always be a change in the intensity, as the decision 215 causes the pixel to be changed to white (237) or black (228). Lee et al. FIG. 2A, Col. 1-21. Moreover, Lee et al. is related to “a method ... to convert a gray scale image into a binary image with halftone dots.” Col. 2, ln. 35-37 (emphasis added). Therefore, according to Lee et al., greyscale image pixels cannot be read onto the term “halftone

image,” as recited in claim 1. Applicants respectfully submit that Lee et al. does not disclose, teach or suggest a determining means that retains the first image data without change when the first image data corresponds to the halftone image as recited in claim 1.

In addition, M.P.E.P. §2143 delineates the three criteria for establishing a *prima facie* case of obviousness as: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Office Action has failed to make a *prima facie* case of obviousness under this M.P.E.P. provision. None of the cited references contains a suggestion or a motivation for their combination. Although the Office Action at page 4 asserts “Lee does not disclose expressly that said black level is a background level, in fact, Lee et al. does expressly teach that “[i]f this gray-scale value is less than the threshold, the pixel is classified as an object pixel, i.e., here black; otherwise, the pixel is classified as a background pixel, i.e., here white.” Col. 6, ln. 9-12 (emphasis added). This teaches away from any combination with Gold’s using a black background level. Therefore, Lee et al. is not combinable with Gold et al. as suggested in the Office Action.

None of the references sets forth a reasonable expectation of success in their combination. The Office Action does not identify where a suggestion to combine the references exists or why a reasonable expectation of success of combining the references exists. Rather, information contained in the current application is impermissibly used, in hindsight, to pick and choose features of the references to combine to arrive at the claimed invention.

Since Lee et al. and Gold do not disclose, teach, or suggest all the limitations of claim 1, nor are the references combinable, claim 1 and dependent claims 2 and 4-6 are not obvious over the cited references. Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claims 1-2 and 4-6 be withdrawn.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee et al. in view of Gold et al., and further in view of Stoffel (US 4,194,221). This rejection is respectfully traversed. Claim 3 depends from claim 1 and is patentable at least for the reasons mentioned above, and on its own merits. Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claim 3 be withdrawn and the claim allowed.

Claims 7-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee et al. in view of Gold et al., and further in view of Sakamoto et al. (US 5,235,436). This rejection is respectfully traversed. Claims 7-9 depend from claim 1 and are patentable at least for the reasons mentioned above, and on their own merits. Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claims 7-9 be withdrawn and the claims allowed.

Claims 10-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee et al. in view of Gold et al., and further in view of Hanyu (US 5,995,658). This rejection is respectfully traversed. None of Lee et al., Gold et al, nor Hanyu, even when considered in combination, teaches or suggests all limitations of independent claims 10 or 11.

Claims 10 and 11 recite an image data correcting device comprising, *inter alia*, “determining means for determining whether the first image data corresponds to a halftone image; and intensity changing means for changing an intensity of the first image data to a predetermined low intensity, ... wherein the determining means retains

the first image data without change when the first image data corresponds to the halftone image, and wherein said predetermined low intensity corresponds to a background level" (emphasis added). Lee et al. does not teach or suggest these limitations.

As discussed above regarding the patentability of claim 1, Lee et al. discloses that "[o]nce the halftone pixels in a document image are labeled as represented in the halftone line map on output 18 of FIG. 1, halftone pixel removal process 20 of FIG. 1 is started and strictly applied to the halftone pixels only." In addition, in FIG. 2A of Lee, if a gray-scale pixel triggers the "NO" path 211, there will always be a change in the intensity, as the decision 215 causes the pixel to be changed to white (237) or black (228). Moreover, Lee et al. is related to a method to "convert a gray scale image into a binary image with halftone dots." Therefore, according to Lee et al., greyscale image pixels cannot be read onto the term "halftone image," as recited in claim 1. Applicants respectfully submit that Lee et al. does not disclose, teach or suggest a determining means that retains the first image data without change when the first image data corresponds to the halftone image as recited in claims 10-11.

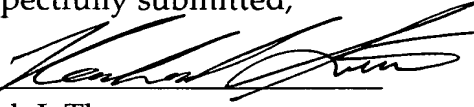
Nor is Gold et al. cited for these limitations. Thus, Gold et al. does not remedy the deficiencies of Lee et al. Hanyu is also not cited for these limitations. Hanyu does not remedy the deficiencies of Lee et al. and Gold et al.

Since Lee et al., Gold et al., and Hanyu do not teach or suggest all of the limitations of claims 10-11, nor are the references combinable, claims 10-11 are not obvious over the cited references. Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claims 10-11 be withdrawn and the claims allowed.

In view of the above, Applicants believe the pending application is in condition for allowance.

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Respectfully submitted,

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